

Appln. No. 10/037,942
Response dated July 12, 2004
Reply to Notice of Non-Compliant Amendment date June 29, 2004

REMARKS/ARGUMENTS

Claims 1-12 and 15-22 are pending in the present Application. Claims 1-12, 15, 21 and 22 stand rejected under 35 USC 103(a) as unpatentable over Grinshpun et al. (US 6,226,943). Claims 16-20 stand rejected under 35 USC 103(a) as unpatentable over Grinshpun et al. in view of Malone (US 4,824,720). Applicant respectfully traverses all rejections and request reconsideration of Claims 1-12 and 15-22 in view of the following remarks.

Amendment to Claim 1 specifying that the cavity panel fits fully within a cavity defined by cavity walls has support in the present Application on page 22, lines 15-22 and in Figures 2C, 4B and 5B. Applicant believes the amendment is not necessary for patentability (as explained below), but serves to more clearly define the invention.

Apart from the present amendment, Claim 1 specifies a panel that "when in a cavity defined by cavity walls, has compressive recovery that supplies sufficient pressure against the cavity walls to frictionally retain the building panel within the cavity" (emphasis added). Irah H. Donner, in his treatise Patent Prosecution: Practice & Procedure Before the U.S. Patent Office; 3rd ed., page 1191, states: "The word 'a' is generally interpreted to mean one or more. ... However, where the specification does not support the possibility of more than one device, the word 'a' has been interpreted to have 'its normal singular meaning.'" In reaching this conclusion, Donner cites North Am. Vaccine, Inc. v. American Cyanamid Co., 7 F.3d 1571 (Fed. Cir. 1993) and Insituform Techs., Inc. v. Cat Contracting, Inc., 99 F.3d 1098 (Fed. Cir. 1996).

The present application does not support a plural interpretation of "a cavity" in the context of Claim 1 where a panel is "in a cavity." The present specification only describes positioning a panel of the present invention into a *single* cavity (see, e.g., each Figure, the supporting text for the Figures, the use of a single testing cavity in each Example, as well as the method taught on page 3, lines 19-22 which refers to "inserting at least one panel within the cavity). Applicant fails to find any support for a plural interpretation in the present specification. Therefore, Applicant contends that the only and proper interpretation of element (d) in Claim 1, even prior to the present amendment, refers to a panel within a single cavity. If the Examiner disagrees with this interpretation, Applicant respectfully requests guidance to support in the present specification for a plural interpretation of "a cavity" when in reference to the present invention.

In contrast to the present invention, Grinshpun describes a panel that *necessarily* extends beyond a single cavity by fundamental design in order to "receive and tightly fit around a support member" (see, e.g., abstract). It is by tightly fitting around a support member that the panel of Grinshpun is held in place – the panel pinches or clamps onto a support member. It is this clamping action that the Office asserts provides the presently claimed compressive recovery that causes frictional retention of the panel within the cavity (page 4, lines 1-2 of Office Action dated 13 April 2004). However, the clamping action *requires* that the panel extend to more than one cavity and does not require or even suggest in any way that the compressive recovery within a single cavity is sufficient to retain the panel within the cavity. A

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panel cannot clamp to a cavity wall without having at least a portion of the panel on an opposing side of a cavity wall and, thereby, in an adjacent cavity. This is made evident, e.g., in each figure of Grinshpun and throughout the Grinshpun teachings. Applicant fails to find any teaching or suggestion in Grinshpun of a panel that can be frictionally retained within a single cavity – the Grinshpun panels necessarily require spanning more than one cavity to even attempt to establish that they are frictionally retained. Malone fails to provide any such teaching either. Therefore, even without the present amendment, Applicant believes Claim 1 (and each of Claims 2-12 and 15-22 which depend from Claim 1) of the present is both novel and unobvious over Grinshpun alone or in combination with Malone.

As amended, the presently claimed invention must fit fully within a cavity and frictionally retain itself within that cavity. This amendment highlights the single cavity interpretation already discussed and excludes a panel that cannot fit within a single cavity. The panel of Grinshpun does not fit fully within a single cavity. Applicant fails to find any motivation to even consider a panel that fits fully within a single cavity in either Grinshpun or Malone. Therefore, Applicant believes that the presently claimed invention is patentable over Grinshpun alone, or in combination with Malone.

ADDITIONAL REMARKS/CLARIFICATIONS

The Office suggests that Figure 6, number 60 of Grinshpun illustrates a domain that extends from a primary face to an opposing face (page 3, paragraph 1 of Office Action dated 13 April 2004). Applicant respectfully disagrees since element 60 does not extend to the top-most face of the panel in Figure 6. Therefore, Applicant does not see how domain 60 extends from a primary face to an opposing face of the panel. However, Applicant respectfully acknowledges that domain 52 of Figure 5 extends from one primary face to an opposing face.

The Office suggests that compressible and resilient foam portion 61 of Figure 6 allow the panel to bend into a non-planar configuration (page 3, paragraph 1 of Office Action dated 13 April 2004). Applicant respectfully disagrees. At no point in the panel of Figure 6 does the resilient foam domain extend all the way through the panel thickness. Therefore, Applicant expects "rigid foam 60" (see column 4, lines 65-66), which is continuous along one face of the panel, to prevent bending of the panel into a non-planar configuration. Applicant respectfully requests further explanation of how domain 61 can facilitate bending of the panel in Figure 6 into a non-planar configuration.

The Office suggests that teaching on column 5, lines 2-5 of Grinshpun discloses compressible domain(s) that, when compressed, reduces at least one dimension of the panel (page 3, paragraph 1- page 4, paragraph 1 of Office Action dated 13 April 2004). Applicant fails to see what dimension of the panel is reduced upon compression of the compressible domain in Grinshpun. The compressible domain(s) do not extend the height or width of the panel. Therefore, Applicant fails to see how compressing the domains can affect the panel's height, width, or even length. Applicant respectfully requests further explanation of how the cited teaching

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in Grinshpun can lead to a panel that reduces a dimension when a compressible domain is compressed.

In view of the present remarks, Applicant respectfully requests withdrawal of all rejections and allowance of Claims 1-12 and 15-22 of the present Application at an early date.

Respectfully submitted,



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